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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,887	08/04/2003	Michael Francis X. Gigliotti JR.	132497	6533
6147 7590 02/27/2007 GENERAL ELECTRIC COMPANY GLOBAL RESEARCH PATENT DOCKET RM. BLDG. K1-4A59 NISKAYUNA, NY 12309			EXAMINER ZIMMER, MARC S	
			ART UNIT 1712	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/633,887

Applicant(s)

GIGLIOTTI ET AL.

Examiner

Marc S. Zimmer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,9-11,13,15-17,19-21,27,39 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-43 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9-11,13,15-17,19-21,27,39 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/04/03, 12/15/03</u> . | 6) <input type="checkbox"/> Other: _____  |

In the last correspondence, the Examiner held as unpatentable most of the claims over *Moravek* in view of an e-mail disclosure from an employee of the Benjamin Moore Company, makers of a commercial product that *Moravek* mentions as emblematic of the paints employed in their invention. In particular, the Examiner inquired of an attorney at the Benjamin Moore Company as to whether or not she could confirm that (i) the aluminum material from which the aluminum paste product that represents one component of the Benjamin Moore paint product was prepared using aluminum flakes, and (ii) that the solvent employed in that paint formulation was one or more of the same diluents outlined in Applicant's claims.

Applicant has called into question the suitability of the Examiner's e-mail correspondence with the aforementioned employee of Benjamin Moore Company as a proper supporting reference. The problems associated with the utilization of this correspondence to support the Examiner's conclusions are acknowledged and that an affidavit that attests to the presence of these materials in the Benjamin Moore paint recited by *Moravek* would perhaps represent a more appropriate foundation for maintaining the rejection. Insofar as identifying the best person to verify these statements made by Ms. Ewing and the actual procurement of an affidavit from that person are beyond the means of the Examiner, a new line of argument is presented herein.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 9-11, 13, 15-17, 19-21, 27, 39, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moravek et al, U.S. Patent # 6,805,906 in view of Reinhardt et al., U.S. patent # 6,153,054 and Vogt, U.S. Patent # 5,441,564.

Moravek is relevant for all of the reasons cited earlier. The shortcomings of Moravek are (i) that it does not indicate what solvent is used in the inventive coating described therein and (ii) that it does not verify that the aluminum paste that represents one component of the Benjamin Moore paint product M66-79 is prepared using aluminum flakes.

Concerning the failure of the reference to disclose one or more of the solvents set out in claim 1, the Examiner takes notice of the fact that the list provided in claim 1 is inclusive of virtually all the solvents that are known to be used in coating formulations. Moreover, it is the Examiner's position that the skilled artisan is capable of selecting those solvents that are most advantageous in terms of their ability to solvate the binder and other components of the paint, toxicity, volatility, etc.

As for the matter of whether the paint described by the reference contains aluminum flakes or even whether one of ordinary skill in the art would have been motivated to use a paste derived from aluminum flake, what seems not to be in question based on a survey of the prior art is that all aluminum pigment pastes are made from aluminum powders and that aluminum flake is regarded as a species within the genus that is aluminum powders that differ primarily in their shape. Aluminum flake, unlike

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other forms of aluminum powder including those that are approximately spherical, are characterized by a relatively high aspect ratio, which is the ratio of a particles largest and smallest dimensions.

The Examiner's survey of the prior art seems to confirm that, in the vast majority of cases in which an aluminum pigment is employed, the pigment is one that was prepared using flakes obtained by wet milling an aluminum powder. Still, this fact alone does not support a holding of prima facie obviousness.

On the other hand, Reinhardt and Vogt both seem to indicate that a flake form is preferred for the brightness/luster/brilliance it imparts to the coating. Vogt refers to the flakes as platelets and documents this effect in the first paragraph under the heading "Background of the Invention". Reinhardt describes coatings that employ aluminum hydroxide pigment and, relevant to the present discussion, it is said of an experiment where aluminum hydroxide is used alone (Example 2) that it has a low luster due to the, "not-so-developed lamellar structure" and, hence, the particles are not favorably oriented parallel to the plane of the substrate being coated. The skilled artisan will appreciate that "lamellar" is synonymous with "plate-like" and, in turn, "flake" and, therefore, an equivalent way of expressing the teaching taken from Reinhardt is that the pigment was not sufficiently flake-like to have the desirable level of luster.

It is, therefore, the Examiner's position that, even if the paste that makes up a key ingredient of the base paint formulation to which Moravek adds aluminum powder, is made from aluminum powder other than aluminum flake (which, incidentally, is not at all clear), it would be obvious to replace that paste with one that is prepared from

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aluminum flake to enhance the luster of the coating over that which would be observed using other forms of aluminum powder.

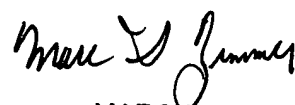
***Allowable Subject Matter***

Claims 41-43 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
MARC S. ZIMMER  
PRIMARY EXAMINER